

REMARKS/ARGUMENTS

Claim 1 has been amended to remove the boronic compound of component (B) from the claims. This amendment was discussed during the interview of November 16, 2011, for which Applicants thank the Examiner. Other amendments are conforming in nature. Support for new Claim 21 is found in Claim 1 as filed. No new matter has been added.

Applicants would like to thank Examiner Goloboy for the helpful and courteous discussion held November 16, 2011. During this discussion Applicants noted that the present rejection critically relies on Morita for its disclosure of Component (E) ashless dispersants therein, the rejection focusing on paragraphs [0058]-[0061] of corresponding U.S. Pub 2004/0192562. This reliance was acknowledged during the interview, as was the fact that these “high molecular weight” succinimides were borated. See, for example, page 3, lines 8-12 of the Official Action. In this regard, Applicants’ representative referred to paragraph [0050] of the reference, which states:

[0050] Component (E) of the lubricating oil composition of the present invention is a boron-containing ashless dispersant. Component (E) importantly contains boron. In the case where a boron-free ashless dispersant is used as Component (E), it can not achieve the purposes of the present invention because it not only fails to inhibit fatigue caused by pitching or flaking and provide anti-shudder properties but also becomes ineffective in anti-wear properties and oxidation stability as a lubricating oil composition even though it is used in combination with Components (B) and (C)

As noted above, Claim 1 has been amended to remove the boronic compound of component (B) from the claims. Thus, no reference of record discloses or suggests at least presently claimed component (B), a succinimide compound having an alkenyl group of a number average molecular weight of 800 to 3,500. Moreover, the fact that Morita has been cited as teaching the use of a boronic compound of such a succinimide compound, and in fact has taught those of ordinary skill in the art that such succinimide compounds must be borated or they would fail to inhibit fatigue caused by pitching or flaking, fail to provide anti-shudder properties, and be ineffective in providing both anti-wear properties and oxidation stability, clearly teaches away from the use of Applicants' presently claimed Component (B):

Whether prior art invalidates a patent claim as obvious is determined from the perspective of one of ordinary skill in the art. *Id.* at 420 (“The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art.”). Through the lens of one of ordinary skill in the art, even when all claim limitations are found in prior art references, **the fact-finder must not only determine what the prior art teaches, but whether prior art teaches away from the claimed invention** and whether there is a motivation to combine teachings from separate references. See *Dystar Textilfarben GMBH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 [80 USPQ2d 1641] (Fed. Cir. 2006) (citing *In re Fulton*, 391 F.3d 1195, 1199-1200 [73 USPQ2d 1141] (Fed. Cir. 2004)). Ultimately, obviousness requires careful judgment and analysis in light of technical facts. *KSR*, 383 U.S. at 419; see also *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997) (“[T]here is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art.”).

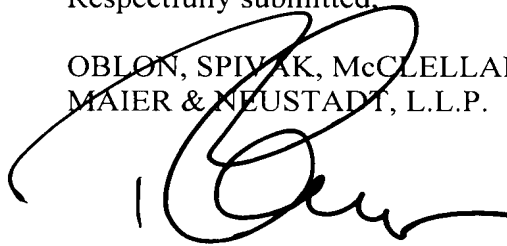
Star Scientific Inc. v. R.J. Reynolds Tobacco Co., 99 USPQ2d 1924, 1931 (Fed. Cir. 2011) (emphasis added).

Because it is clear here that the art not only teaches away from the use of Applicants' component (B) succinimides herein, but in fact teaches against such use, Applicants respectfully submit, as they did during the interview, that the combination of references applied against the claims herein cannot present a *prima facie* case of obviousness.

For these reasons, and in view of the fact that no reference of record overcomes the teachings of the applied references that direct those of ordinary skill *not* to use Applicants' claimed components in their claimed combination, the rejections over Morita in view of Kadkhodyan, optionally in view of Koshima, should be reconsidered and withdrawn, and this case passed to Issue.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Richard L. Treanor', is written over a horizontal line.

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